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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/512,894	02/24/00	OBERTH	M 33/759

000757
BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO IL 60610

PM82/0706

EXAMINER
HARTMANN, G

ART UNIT 3673 PAPER NUMBER

DATE MAILED: 07/06/01 *g*

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)
	09/512,894	OBERTH ET AL.
Examiner	Art Unit	
Gary Hartmann	3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 16 April 2001.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 18-74 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) 18 is/are allowed.

6) Claim(s) 19-28 and 30-74 is/are rejected.

7) Claim(s) 29 is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) Notice of References Cited (PTO-892) 18) Interview Summary (PTO-413) Paper No(s). _____

16) Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) Notice of Informal Patent Application (PTO-152)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 20) Other: _____

DETAILED ACTION

Claim Rejections - 35 U.S.C. § 251

1. Claims 19-28 and 30-68 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The omission of the single rail from the claim language of independent claims 19-21 necessitates this rejection based on recapture. For example, see in parent application 08/558,109: paper #7 (1/21/97), in which only claims including a single rail were elected; paper #10 (5/2/97), especially paragraphs 3-5, in which arguments are made regarding the single rail of the present invention with respect to the prior art; and paper #14 (9/2/97), especially at the last 2 paragraphs of page 4, in which arguments are made regarding the advantages of the single rail and that the prior art does not teach the structure including the single rail.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 72 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 72 recites the limitation "the first and second rail assembly " in line 2. There is insufficient antecedent basis for this limitation in the claim. This claim appears to have been intended to depend from claim 71.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 69-74, as they depend from claim 20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Urlberger (German Patent 37 08 861). Urlberger discloses a highway crash cushion having a diaphragm (4) and absorbing element (2) and further comprising a single rail support structure (10) disposed under the crash cushion and anchored to a support surface; the support structure being shaped to restrict movement of the diaphragm with respect to the support structure in at least one lateral direction. There is a guide (14) coupled to the diaphragm and mounted to slide along the support structure. The support structure does not appear to

include a plurality of segments; however, it would have been obvious to one of ordinary skill at the time the invention was made to have at least two axially aligned, releasably interconnected segments in order to ease manufacture, transportation, and installation of the rail.

The single rail assembly is substantially centered with respect to the diaphragm.

The rail assembly includes first and second laterally spaced and axially extending elements positioned to restrict upward movement of the guide (Figure 4).

The guide comprises first and second guide elements (16) positioned below the rail assembly elements.

The rail assembly elements (top flanges, for example) comprise downwardly facing surfaces and are horizontally extending.

Allowable Subject Matter

6. Claim 18 is allowed.
7. Claim 29 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
8. Claims 69-71, 73, and 74, as they depend from claims 19 or 21 only, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
9. Claim 72, as it depends from claims 19 or 21 only, would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

10. Applicant's arguments filed 4/16/01 have been fully considered but they are not persuasive. The arguments regarding *Hester* are noted; however, this is not the only test to determine if there is improper recapture. Claiming subject matter in a reissue application which was canceled in response to a restriction requirement during prosecution of the original patent is an error which may not be corrected by reissue. *In re Orita*, 193 USPQ 145. Reissue may not be utilized to reclaim subject matter which was nonelected in the original application. 35 U.S.C. 251 cannot be used to circumvent other statutory requirements; e.g., the copendency requirement of 35 U.S.C. 120 for filing divisional applications on nonelected subject matter. This also applies to broadened variations of nonelected subject matter. In the examiner's opinion, independent claims 19-21 have been broadened in a manner which circumvents the restriction requirement and omits subject matter (the single rail) important in the prosecution of the parent application.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Hartmann whose telephone number is 703-305-4549. The examiner can normally be reached on Monday through Friday, 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Will can be reached on 703-308-3870. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3597 for regular communications and 703-305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



**Gary Hartmann
Patent Examiner
Art Unit 3673**

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June 29, 2001